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10/724,839	12/01/2003	Gregory Dean Sunvold	P147	2171

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EXAMINER
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OLSON, ERIC

ART UNIT	PAPER NUMBER
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1623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/724,839	<b>Applicant(s)</b> SUNVOLD ET AL.	
	<b>Examiner</b> Eric S. Olson	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 and 56-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **Detailed Action**

This office action is a response to applicant's communication submitted February 15, 2008 wherein claims 6, 7, 21, 22, 36, 37, 44, 45, 49, 50, 59, and 60 are amended. This application was filed December 1, 2003 and makes no priority claims.

Claims 1-63 are pending in this application.

Claims 32-55 as amended are examined on the merits herein.

The terminal disclaimers filed on December 20, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on copending applications 10/725251 and 10/725248, have been reviewed and are accepted. The terminal disclaimers have been recorded and are further discussed below as they bear on rejections of record in the previous office action.

Applicant's amendment, submitted February 15, 2008, with respect to the rejection of instant claims 36, 37, 44, 45, 49, and 50 under 35 USC 112, second paragraph for reciting the indefinite phrases, "the fructooligosaccharide comprises inulin," and "the fructooligosaccharide comprises chicory," has been fully considered and found to be persuasive to remove the rejection as the indefinite phrases have been removed from the claims. Therefore the rejection is withdrawn.

Applicant's terminal disclaimer, submitted December 20, 2007, with respect to the rejection of instant claims 32, 33, 35, 38-43, 46-48, and 51-55 under the doctrine of obviousness-type double patenting for claiming the same invention as claims 9-20 of copending application 10/725251, has been fully considered and found to be persuasive to remove the rejection as the terminal disclaimer is found to be proper. Therefore the rejection is withdrawn.

Applicant's terminal disclaimer, submitted December 20, 2007, with respect to the rejection of instant claims 32, 33, 47, and 48 under the doctrine of obviousness-type double patenting for claiming the same invention as claims 37-40, 46, and 47 of copending application 10/725248, has been fully considered and found to be persuasive to remove the rejection as the terminal disclaimer is found to be proper. Therefore the rejection is withdrawn.

The following new grounds of rejection are introduced:

***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 32-36 and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayek et al. (US patent 5958898, cited in PTO-1449) Hayek et al. discloses a method comprising feeding an animal a diet containing fermentable fibers. (column 1 lines 40-60) The fermentable fibers are preferably selected from various fibers including fructooligosaccharides and inulin. (column 2 lines 18-21) In example 1, column 4, lines 13-28, an example is described in which dogs were fed a daily nutritionally balanced diet containing 1.5% fructooligosaccharides. Because the method described by Hayek et al. involves administering the same compounds to the same subjects in the same amounts as the claimed invention, any properties or effects of this method, such as improving bone health, strength, physical activity performance, calcium absorption, and other effects mentioned in the instant claims, are inherent in the disclosed method. See *Ex parte Novitski* 26 USPQ 2d 1389, 1391 (Bd. Pat. App. & Int. 1993). Note that the claiming of a new use, new function, or unknown property which is inherently present in the prior art does not make the claim patentable. See *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F3c. 955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001) with regard to inherency as it relates to the claimed invention herein. Therefore Hayek et al. anticipates the claimed invention.

Claims 32-34 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Loo et al. (US patent 6500805, cited in PTO-892) Van Loo et al. discloses a

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method comprising administering fructans to an animal. (column 4 lines 12-28) In a preferred embodiment the fructan is inulin. (column 4 lines 61-67) Chicory inulin is preferred. (column 5 lines 8-10) In a disclosed example rats were fed a diet comprising 10% chicory inulin. (column 7 lines 12-55) Note that rats can be companion animals. Furthermore claims 11 and 15 of Van Loo et al. define the subject population for this method as being a human, a dog, or a cat. Because the method described by Van Loo et al. involves administering the same compounds to the same subjects in the same amounts as the claimed invention, any properties or effects of this method, such as improving bone health, strength, physical activity performance, calcium absorption, and other effects mentioned in the instant claims, are inherent in the disclosed method. See *Ex parte Novitski* 26 USPQ 2d 1389, 1391 (Bd. Pat. App. & Int. 1993). Note that the claiming of a new use, new function, or unknown property which is inherently present in the prior art does not make the claim patentable. See *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F.3d 955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001) with regard to inherency as it relates to the claimed invention herein. Therefore Van Loo et al. anticipates the claimed invention.

### ***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayek et al. (US patent 5958898, cited in PTO-1449) The disclosure of Hayek et al. is discussed above. Hayek et al. does not specifically exemplify a method in which the composition being administered comprises about 0.01-0.2% fructooligosaccharides.

It would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of Hayek et al. using a composition comprising 0.01-0.2% fructooligosaccharide. One of ordinary skill in the art would have been able to adjust the dosages and total volume of the compositions to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Thus the invention taken as a whole is *prima facie* obvious.

Claims 35-37, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Loo et al. (US patent 6500805, cited in PTO-892) The disclosure of Van Loo et al. is discussed above. Van Loo et al. does not specifically exemplify a method in which the composition being administered comprises about 0.01-5%, 0.01-2%, or 0.01-0.2% fructooligosaccharides.

It would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of Van Loo et al. using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust the dosages and total volume of the compositions to determine the

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optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Thus the invention taken as a whole is *prima facie* obvious.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7-8 of U.S. Patent No. 6306442. (Cited in PTO-892, herein referred to as ‘442) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 7-8 of ‘442 anticipate the claimed invention or render it obvious. Claim 1 of ‘442 claims a method comprising administering a composition to a



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companion animal containing 25% dietary fiber of which 1-11 weight percent is supplemental dietary fiber, or about 0.25-2.75% of the total. Claims 2-4 specify that the amount of supplemental fiber is 2-9, 3-7, or 4-7 percent, for 1-1.75% of the total weight of the composition. Claims 7-8 specify a number of different possible fibers including fructooligosaccharides. Thus the claimed subject matter is anticipated by claims 1-4, 7, and 8 of '442. Although claims 1-4, 7, and 8 of '442 do not specify an amount of fructooligosaccharide of 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '442 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust the dosages and total volume of the compositions to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6475512. (Cited in PTO-892, herein referred to as '512) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of '512 anticipate the claimed invention or render it obvious. Claim 1 of '512 claims a method comprising administering a composition to a companion animal containing 1-11 weight percent supplemental dietary fiber which includes fructooligosaccharides. Claims 2-4 specify that the amount of supplemental fiber is 2-10, 3-9, or 4-7 percent. Claim 5 specifies that the animal is a dog. Although claims 1-5

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of '512 do not specify an amount of fructooligosaccharide of 0.01-5%, 0.01-2%, or 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '512 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust amounts of fructooligosaccharide compared to other supplemental fibers in the composition to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Reissue Patent No. RE38112. (Cited in PTO-1449, herein referred to as '112) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of '112 anticipate the claimed invention or render it obvious. Claim 1 of '112 claims a method comprising administering a composition to a companion animal containing 1-11 weight percent supplemental dietary fiber which includes fructooligosaccharides. Claims 2-4 specify that the amount of supplemental fiber is 2-10, 3-9, or 4-7 percent. Claim 5 specifies that the animal is a dog. Although claims 1-5 of '112 do not specify an amount of fructooligosaccharide of 0.01-5%, 0.01-2%, or 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '112 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust amounts of fructooligosaccharide compared to other supplemental fibers in the

composition to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6818225. (Cited in PTO-892, herein referred to as '225) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 of '225 anticipate the claimed invention or render it obvious. Claim 1 of '225 claims a method comprising administering a composition to a companion animal containing 1-11 weight percent supplemental dietary fiber which includes fructooligosaccharides. Claims 2-4 specify that the amount of supplemental fiber is 2-10, 3-9, or 4-7 percent. Although claims 1-4 of '512 do not specify an amount of fructooligosaccharide of 0.01-5%, 0.01-2%, or 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '225 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust amounts of fructooligosaccharide compared to other supplemental fibers in the composition to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7 of U.S. Patent No. 5958898. (Cited in PTO-1449, herein referred to as '898) Although the

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conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 7 of '898 anticipate the claimed invention or render it obvious. Claim 1 of '898 claims a method comprising administering a composition to a companion animal containing 1-11 weight percent supplemental dietary fiber which includes fructooligosaccharides. Claims 2-4 specify that the amount of supplemental fiber is 2-10, 3-9, or 4-7 percent. Claim 7 specifies that the animal is a dog. Although claims 1-5 of '512 do not specify an amount of fructooligosaccharide of 0.01-5%, 0.01-2%, or 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '898 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust amounts of fructooligosaccharide compared to other supplemental fibers in the composition to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6180131. (Cited in PTO-892, herein referred to as '131) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of '131 anticipate the claimed invention or render it obvious. Claim 1 of '131 claims a method comprising administering a composition to a companion animal containing 1-11 weight percent supplemental dietary fiber which includes fructooligosaccharides. Claims 2-4 specify that the amount of supplemental fiber is 2-

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10, 3-9, or 4-7 percent. Claim 5 specifies that the animal is a dog. Although claims 1-5 of '131 do not specify an amount of fructooligosaccharide of 0.01-5%, 0.01-2%, or 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '131 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust amounts of fructooligosaccharide compared to other supplemental fibers in the composition to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7-8 of U.S. Patent No. 5965175. (Cited in PTO-1449, herein referred to as '175) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 7-8 of '175 anticipate the claimed invention or render it obvious. Claim 1 of '175 claims a method comprising administering a composition to a dog containing 1-11 weight percent supplemental dietary fiber. Claims 2-4 specify that the amount of supplemental fiber is 2-9, 3-7, or 4-7 percent. Claims 7-8 specify a number of different possible fibers including fructooligosaccharides. Although claims 1-4, 7, and 8 of '175 do not specify an amount of fructooligosaccharide of 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '175 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust

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the dosages and total volume of the compositions to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Claims 32-35, 47, and 48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7-8, and 23 of U.S. Patent No. 6093418. (Cited in PTO-1449, herein referred to as '418) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4, 7-8, and 23 of '418 anticipate the claimed invention or render it obvious. Claim 1 of '418 claims a method comprising administering a composition to a companion animal containing 1-11 weight percent supplemental dietary fiber. Claims 2-4 specify that the amount of supplemental fiber is 2-9, 3-7, or 4-7 percent. Claims 7-8 specify a number of different possible fibers including fructooligosaccharides. Claim 23 specifies that the companion animal is a dog. Although claims 1-4, 7, 8, and 23 of '418 do not specify an amount of fructooligosaccharide of 0.01-0.2%, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of '418 using a composition comprising the claimed amounts of fructooligosaccharide. One of ordinary skill in the art would have been able to adjust the dosages and total volume of the compositions to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

The following rejections of record in the previous office action are maintained:

***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32-37 and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Vickers et. al. (American Journal of Veterinary Research (AJVR) 62(4), 2001, 609-615; of record in previous action).

Vickers et. al. teaches that the use of fructooligosaccharides (FOS) in canine diets acts as a colonic stimuli and has important physiologic and anatomic effects on the nutritional status of dogs. Inulin and chicory are disclosed as sources of fructooligosaccharide. (Page 609, Column 1, first paragraph; Page 610, Column 1, paragraph 5). Vickers disclose that the use of fermentable fiber blends decreases urinary excretion of nitrogen while increasing fecal excretion of nitrogen without compromising delivery of essential nutrients to the host. The repartitioning of nitrogen reduces the reliance on the kidneys for nitrogen disposal. (Page 614, Column 1, Paragraph 2). Consumption of FOS is reported to promote beneficial microflora which aid in the suppression of potentially pathogenic bacteria. (Page 609, Column 1, last paragraph). These effects are expected to improve the physical activity performance of a companion animal. Because the method described by Vickers et al. involves administering the same compounds to the same subjects in the same amounts as the claimed invention, any properties or effects of this method, such as improving bone

health, strength, physical activity performance, calcium absorption, and other effects mentioned in the instant claims, are inherent in the disclosed method. See *Ex parte Novitski* 26 USPQ 2d 1389, 1391 (Bd. Pat. App. & Int. 1993). Note that the claiming of a new use, new function, or unknown property which is inherently present in the prior art does not make the claim patentable. See *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F3c. 955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001) with regard to inherency as it relates to the claimed invention herein. Therefore Vickers et al. anticipates the claimed invention.

Response to Argument: Applicant's arguments, submitted February 15, 2008, with respect to the above ground of rejection, have been fully considered and not found to be persuasive to remove the rejection. Applicant argues that the reference fails to teach the claimed effects of the composition (i.e. enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance, and combinations thereof. However, as mentioned in the body of the rejection, these effects are inherent in the disclosed method. Therefore the rejection is deemed proper and maintained.

Claims 32-35, 38-40, 47-48 and 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard et. al. (Nutrition Research, 2000, 20(10), 1473- 1484; of record in previous action).

Howard et. al. discloses feeding dogs that contain fructooligosaccharides (FOS). (Abstract). The FOS used was Nutraflora at 1.5%. (Table 1, Page 1474, and Page



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1474, last paragraph). Note that Nutraflora is described in the instant specification as having 34% 1-kestose, 55% nystose and 10% 1 F-beta- fructofuranosyinyntose. (Specification, Page 4, second paragraph). Howard describes that the incorporation of fermentable fiber into diet has several beneficial effects including, reducing colonic histopathologies, beneficially altering the intestinal microflora and reducing blood urea and renal N excretion. (Page 1473, introduction). Howard discloses that dry matter intake was reduced with FOS containing diets. These effects are expected to improve the physical activity performance of a companion animal. Because the method described by Howard et al. involves administering the same compounds to the same subjects in the same amounts as the claimed invention, any properties or effects of this method, such as improving bone health, strength, physical activity performance, calcium absorption, and other effects mentioned in the instant claims, are inherent in the disclosed method. See *Ex parte Novitski* 26 USPQ 2d 1389, 1391 (Bd. Pat. App. & Int. 1993). Note that the claiming of a new use, new function, or unknown property which is inherently present in the prior art does not make the claim patentable. See *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F3c. 955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001) with regard to inherency as it relates to the claimed invention herein. Therefore Howard et al. anticipates the claimed invention.

Response to Argument: Applicant's arguments, submitted February 15, 2008, with respect to the above ground of rejection, have been fully considered and not found to be persuasive to remove the rejection. Applicant argues that the reference fails to

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teach the claimed effects of the composition (i.e. enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance, and combinations thereof. However, as mentioned in the body of the rejection, these effects are inherent in the disclosed method. Therefore the rejection is deemed proper and maintained.

Claims 32, 33, 35, 37, 47, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Sparks et. al. (American Journal of Veterinary Research, AJVR 59(4) 1998, 431-435; of record in previous action).

Sparks et. al. discloses the use of FOS supplemented diets for cats to modify flora. FOS was substituted at a rate of 0.75% of the dry weight. (Page 431, Column 2, paragraph 4). The alternations in flora is considered to improve physical activity performance of cats. Because the method described by Sparks et al. involves administering the same compounds to the same subjects in the same amounts as the claimed invention, any properties or effects of this method, such as improving bone health, strength, physical activity performance, calcium absorption, and other effects mentioned in the instant claims, are inherent in the disclosed method. See *Ex parte Novitski* 26 USPQ 2d 1389, 1391 (Bd. Pat. App. & Int. 1993). Note that the claiming of a new use, new function, or unknown property which is inherently present in the prior art does not make the claim patentable. See *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *Eli Lilly and Co. v. Barr Laboratories Inc.* 251 F3c.

955; 58 USPQ2d 1869-1881 (Fed. Cir. 2001) with regard to inherency as it relates to the claimed invention herein. Therefore Sparks et al. anticipates the claimed invention.

Response to Argument: Applicant's arguments, submitted February 15, 2008, with respect to the above ground of rejection, have been fully considered and not found to be persuasive to remove the rejection. Applicant argues that the reference fails to teach the claimed effects of the composition (i.e. enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance, and combinations thereof. However, as mentioned in the body of the rejection, these effects are inherent in the disclosed method. Therefore the rejection is deemed proper and maintained.

### ***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et. al. (Nutrition Research, 2000, 20(10), 1473-1484; of record in previous action), in view of Roberfroid M. (Nutrition, 16, 2000, 677-679; of record in previous action). The disclosure of Howard et. al. is discussed above. Howard does not expressly disclose the use of inulin and chicory in canine diets.

Roberfroid et. al. discloses that oligofructosaccharides can improve calcium bioavailability. (Page 678, Column 1, paragraph 3 to Column 2, Paragraph 1).

Roberfroid discloses chicory as a source of fructooligosaccharide and inulin as one of the oligofructosaccharides present in chicory. (Page 677, Column 1, paragraph 1 ).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to enhance calcium absorption, to improve physical activity performances, or to produce any of the effects recited by Howard et al. in companion animals by feeding with fructooligosaccharides derived from chicory or inulin or the commercially available Nutraflora because Roberfroid M as well as Howard et. al. discloses beneficial effects for the inclusion of inulin and chicory FOS including increased calcium bioavailability and Howard discusses the use of fructooligosaccharides in companion animal diets. Also, one of ordinary skill in the art would have recognized that chicory and inulin are fructooligosaccharides and therefore usable as fructooligosaccharides in the method of Howard et al. Specifically, one of ordinary skill in the art would have expected that they could be included in the fructooligosaccharide component of the diets described by Howard et al. to produce the beneficial effects on nitrogen excretion described therein.

One of ordinary skill in the art would have been motivated to use oligofructosaccharides in companion animal diets to enhance calcium absorption or to improve physical activity performances in companion animals because Howard et. al. discloses beneficial effects in the use of fructooligosaccharides in companion animals

and Roberfroid discloses that fructooligosaccharides are capable of improving calcium bioavailability.

Therefore, one of ordinary skill in the art would have reasonably expected that the use of oligofructosaccharides in companion animal diets would have resulted in beneficial effects.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to practice the method of Hayek et al. using a composition comprising 0.01-0.2% fructooligosaccharide. One of ordinary skill in the art would have been able to adjust the dosages and total volume of the compositions to determine the optimal composition to use. Doing so is part of the ordinary and routine level of skill in the art.

Thus the claimed invention as a whole is clearly *prima facie* obvious over the combined teachings of the prior art.

Response to Argument: Applicant's arguments, submitted February 15, 2008, with respect to the above ground of rejection, have been fully considered and not found to be persuasive to remove the rejection. Applicant argues that the reference fails to teach the claimed effects of the composition (i.e. enhancing calcium absorption, improving bone health, improving strength, improving physical activity performance, and combinations thereof. This argument is not deemed persuasive for reasons discussed in the 102 rejection over Howard et al. alone. Furthermore, Applicant argues that one of ordinary skill in the art would not have considered the teaching of Roberfroid et al. to be generalizable to humans given the differences between human and canine digestive

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systems. However, as discussed in the body of the rejection, chicory and inulin are species of fructooligosaccharides and therefore included within the broad disclosure of Howard et al. Therefore since Howard et al. already teaches beneficial effects of a variety of FOS, one of ordinary skill in the art would have expected these specific FOS to have the same beneficial effect. Furthermore, given that the results of the calcium absorption studies of Roberfroid et al. were carried out in both rats and humans, one of ordinary skill in the art would have expected that the effects would be observed in a wide range of mammals.

Therefore the rejection is deemed proper and maintained.

### **Conclusion**

No claims are allowed in this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric S. Olson whose telephone number is 571-272-9051. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on (571)272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric S Olson/  
Examiner, Art Unit 1623  
5/6/2008

/Shaojia Anna Jiang, Ph.D./  
Supervisory Patent Examiner, Art Unit 1623